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22470	7590	12/22/2005	EXAMINER	
HAYNES BEFFEL & WOLFELD LLP P O BOX 366 HALF MOON BAY, CA 94019			CHANKONG, DOHM	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. .

09/890,076

Applicant(s)

LUO ET AL.

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22, 25-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1> This action is in response to Applicant's amendment and request for continued examination. Claim 24 has been cancelled. Claims 22 and 39 have been amended. Claims 22 and 25-45 are presented for further examination.

2> This is a non-final rejection.

#### *Continued Examination Under 37 CFR 1.114*

3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11.29.2005 has been entered.

#### *Response to Arguments*

4> Applicant's arguments have been fully considered but they are not persuasive. Applicant has amended independent claims in substance with the limitation of cancelled claim 24. Claim 24 was rejected in the previous Office Action under 35 U.S.C § 103(a) as being unpatentable over Ortony, Orenshteyn and Frese [see Office Action, 8.8.2005, paragraphs 9 and 10]. Specifically, claim 24 is directed towards "a console application" that "learns the network addresses of services in the group". Ortony, the primary reference, did

Art Unit: 2152

not expressly disclose this feature and Orenshteyn was relied upon to teach the feature as well as why its incorporation into Ortony was obvious.

Applicant attacks the basis for this incorporation asserting that certain parts of Orenshteyn have been improperly excised from the reference, excluding other parts of the invention that teach away from the invention. This argument has been carefully considered but is not persuasive for two reasons. First, Ortony is the primary reference; Applicant's argument would be more persuasive if Orenshteyn were the primary reference and explicitly taught away from downloading code. Instead, the combination of Ortony and Frese disclosed downloading code to the device but did not disclose the element of learning network addresses of services. Ortony disclosed utilizing pre-selected addresses of services [column 2 «lines 56-61»]. Orenshteyn's disclosure of learning network addresses of services improved the Ortony-Frese combination by providing a more dynamic means of service discovery [see Office Action, 8.8.2005, paragraphs 9 and 10].

Second, what has been "picked" from Orenshteyn, namely the step of discovering network addresses of services and applications does not seem to rely or depend on the functionality of not downloading the logic to the client computer - incorporating the discovery step does not necessitate incorporating Orenshteyn's remote execution functionality. That is, the act of learning network addresses of services or applications and executing logic on a remote computer (as opposed to downloading the logic) are two separate steps of Orenshteyn's invention and it is the discovery of network addresses step which is being incorporated into the Ortony-Frese references. It is a well known to one of ordinary skill in the art to incorporate different steps The discovery step allows clients to "roam" the

Art Unit: 2152

network looking for application services and replaces the static pre-selected service addresses taught in Ortony-Frese.

Orenshteyn's invention is not being fully incorporated into Ortony-Frese but only the address discovery step as it relates to the limitation of cancelled claim 24. Orenshteyn does not expressly teach away from combining the discovery step with the Ortony-Frese system. Thus, the Office believes the combination of Ortony-Frese-Orenshteyn is proper and read on the elements of Applicant's invention as claimed.

5> Additionally, the new grounds of rejection in this action are necessitated by Applicant's amendment.

*Claim Rejections - 35 USC § 112*

6> Claims 39-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Specifically, claim 39 is rejected for lacking proper antecedent basis : "the network addresses".

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 2152

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7> Claims 22, 25, 28-30, 35, 39, 42 and 45 are rejected under 35 U.S.C § 102(e) as being anticipated by Beck et al, U.S Patent No. 6,604,140 ["Beck"].

8> As to claim 22, Beck discloses a data processing tool for controlling an application accessible via a network, comprising:

a console application including a user interface program [column 4 «lines 10-30»], information about services, including network addresses, in a group of services accessible via the network [column 1 «lines 60-62» | column 4 «lines 10-30 and 45-54»], and a communication driver executing a protocol for communication of the console application with at least one of the services in the group, wherein the protocol includes one or more exchanges in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked, and by which the console application learns the network addresses of services in the group [column 2 «lines 47-63» | column 3 «lines 38-41» | column 4 «lines 10-60» | column 7 «lines 45-62»];

an input/output device supporting the user interface program, wherein the device downloads code controlling the set of services [column 6 «lines 12-24»]; and

a communication port by which access to the network is available [column 7 «lines 45-48»].

Art Unit: 2152

9> As to claim 25, Beck discloses the an exchange in which a particular service in the group of services sends the console application a set of user interface constructs for incorporation in the user interface program [column 4 «lines 10-30» | column 5 «lines 42-46» | column 6 «lines 12-16»].

10> As to claim 28, Beck discloses services including a calendar program [column 8 «lines 49-56»].

11> As to claims 29 and 30, Beck discloses a user interface program for a networked appliance and a print services [column 7 «lines 18-25»].

12> As to claim 35, Beck discloses a port comprising a wireless transmitter and receiver [column 4 «lines 3-9» | column 7 «lines 45-48»].

13> As to claim 39, Beck discloses a method for controlling an application executable on a particular processor coupled to a network using a portable computing platform, comprising:  
establishing a communication link via the network between the portable computing platform and the particular processor by which the portable computing platform learns the network addresses of services in the group [column 3 «lines 48-58» | claims 1, 14, 19 and 20];

Art Unit: 2152

transferring a control program to the portable computing platform via the network, the control program including user interface constructs for generating commands for control of the application [column 5 «lines 38-64» | column 6 «lines 12-44»];

transmitting commands input using the control program to the particular processor via the communication link [column 6 «lines 30-44» | column 7 «lines 32-44»];

transferring the commands input using the control program to the application [column 6 «lines 30-44» | column 7 «lines 32-44»].

14> As to claim 42, Beck discloses a wireless link [column 4 «lines 3-9»].

15> As to claim 45, Beck discloses a portable computing platform that is palm sized [column 3 «lines 48-49»].

### *Claim Rejections - 35 USC § 103*

16> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17> Claims 22, 25, 27, 31, 35, and 37 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony, U.S Patent No. 6.038.595, in view of Orenshteyn, U.S Patent No. 5.889.942, in further view of Frese, II et al, U.S Patent No. 5.909.545 [“Frese”].



18> As to claim 22, Ortony discloses a data processing tool for controlling an application accessible via a network, comprising:

a console application including a user interface program, information about services, including network addresses, in a group of services accessible via the network, and a communication driver executing a protocol for communication of the console application with at least one of the services in the group [column 3 «lines 18-29, 34-48 and 56-65»];

an input/output device supporting the user interface program [column 7 «lines 2-14»];  
and

a communication port by which access to the network is available [column 3 «lines 27-29»].

However, Ortony does not explicitly disclose that the device downloads code controlling the set of services or a tool wherein the protocol includes one or more exchanges in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked, and by which the console application learns the network addresses of services in the group.

19> Ortony does suggest the ability to add functionality with the use of device programs to his portable computer [column 7 «lines 43-51»]. Furthermore, Frese discloses a device downloading code for controlling a set of services [column 4 «lines 25-50»]. Therefore, it would have been obvious to one of ordinary skill in the art to modify Ortony's "device programs" functionality with the downloading and "executable code" functionality disclosed

Art Unit: 2152

by Frese. One would have been particularly motivated to provide such functionality in Ortony to allow programs to be dynamically loaded into the network device, enabling Ortony's portable device to communicate with a wide variety of applications.

Orenshteyn discloses an exchange in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked [column 4 «line 65» to column 5 «line 15» | column 9 «lines 59-67» where : Orenshteyn's directory service is among the group of services accessible to the remote station, and hosts the other services that can be invoked by said station]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Orenshteyn's application host functionality into Ortony to provide a service in the group of services that enhances a client's ability to access the other services.

Also, Orenshteyn discloses a tool wherein the protocol includes an exchange by which the console application learns the network addressed of services in the group [column 5 «lines 8-15»]. It would have been obvious to one of ordinary skill in the art to implement Orenshteyn's address discovery method into Ortony's data processing tool, replacing his static preselected addressing method, and to allow the user to dynamically discover the services provided within his local area network.

20> As to claim 25, Ortony does disclose an exchange in which a particular service sends the console application a set of instructions [column 3 «lines 56-65»] but does not specifically disclose a tool wherein the protocol includes an exchange in which a particular service in the

Art Unit: 2152

group of services sends the console application a set of user interface constructs for incorporation in the user interface program.

21> Orenshiteyn discloses a tool wherein the protocol includes an exchange in which a particular service in the group of services sends the console application a set of user interface constructs for incorporation in the user interface program [column 5 «lines 16-31»]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Orenshiteyn's user interface construct commands into Ortony's server-processing tool system to allow the particular service control over what is displayed on Ortony's data processing tool.

22> As to claim 27, Ortony discloses the data processing tool of claim 22 wherein the particular service in the group comprises an email client program [Figure 2 «item 42»].

23> As to claim 31, Ortony discloses the data processing tool of claim 22 wherein the particular service in the group comprises an internet browser service [column 5 «line 1»].

24> As to claim 35, Ortony discloses the data processing tool of claim 22, wherein the port comprises a wireless transmitter and receiver [Figure 2 «item 50»].

25> As to claim 37, Ortony discloses the data processing tool of claim 22, wherein the input/output device comprises a touch screen [column 2 «lines 43-48»].

Art Unit: 2152

26> Claims 26, 28-30, 32-34 and 38 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony, Orenshteyn and Frese, in further view of an Official Notice.

27> As to claims 26, 28-30 and 32-34, Ortony discloses the use of network services for various purposes [column 5 «lines 1-2»], but does not specifically disclose all the services, as claimed. However, services such as a slide presentation, calendar program, control of appliance, print and fax services, speech translation and room reservation function are well known in the art and not patentably distinct as they are merely fields of use. Therefore, Official Notice is taken that one of ordinary skill in the art would have reasonably implemented the aforementioned services in Ortony to provide a greater range of functionality of services available to the user.

28> As to claim 38, Ortony discloses the use of a touch screen as an input/output device but does not specifically disclose the dimensions as claimed. Official Notice is taken that the dimension of a touch screen on a handheld device is a matter of preference, and one of reasonable skill in the art would have reasonably inferred that the touch screen would have to be at least a minimum size to fit on the handheld or portable device. Therefore, it would have been obvious to implement the size restrictions of 4 inches by 6 inches or smaller on the handheld device to keep the size of the device within the limits of portability. Furthermore, it is simply a matter of design choice that dictates the size of a screen and is not a patentable step.

29> Claim 36 is rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony, Orenshteyn and Frese, in further view of Whitehead et al, U.S Patent No. 6,085,030 [“Whitehead”].

30> Ortony discloses a wireless link, but does not specifically disclose that it is an infrared link, or comprises an infrared transmitter and receiver.

31> Whitehead discloses a communication link comprising an infrared link, and that its use is well known in the art [column 6 «lines 20-25»]. Therefore, it would have been obvious to one of ordinary skill to have reasonably implemented Ortony’s wireless link as an infrared link as taught by Whitehead, thereby increasing the number of computing platforms with which Frese’s system is compatible, most notably, infrared-enabled and wireless devices.

32> Claims 39, 42, 44 and 45 are rejected under 35 U.S.C § 103(a) as being unpatentable over Frese, in view of Ortony, in further view of Orenshteyn.

33> As to claim 39, Frese discloses a method for controlling an application executable on a particular processor coupled to a network using a computing platform, comprising:  
establishing a communication link via the network between the computing platform and the particular processor [Figure 1 «items 16,20» | column 6 «lines 39-59»];

transferring a control program to the computing platform via the network, the control program including user interface constructs for generating commands for control of the application [column 4 «lines 25-32»];

transmitting commands input using the control program to the particular processor via the communication link [column 4 «lines 32-50»];

transferring the commands input using the control program to the application [column 4 «lines 32-50» | column 5 «lines 1-14»].

Frese does not explicitly disclose that the computing platform is portable.

34> Ortony discloses a method for controlling an application executable on a particular processor coupled to a network using a portable computing platform [column 4 «lines 13-31»]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented Frese's computing platform as a portable computing platform to increase the functionality of his invention by allowing portable devices and wireless control of applications in his network as taught by Ortony. Frese further suggests this implementation, disclosing that other computing platforms may be used in his network [column 6 «lines 65-66»].

Orenshteyn discloses a tool wherein the protocol includes an exchange by which the console application learns the network addressed of services in the group [column 5 «lines 8-15»]. It would have been obvious to one of ordinary skill in the art to implement Orenshteyn's address discovery method into Frese's data processing tool enabling the user to dynamically discover the services provided within his local area network ("roam").

Art Unit: 2152

35> As to claim 42, Frese does not disclose a method wherein the communications link comprises a wireless link.

36> Ortony discloses a method wherein the communications link comprises a wireless link [column 4 «lines 23-31»]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented Frese's computing platform as a portable computing platform to increase the functionality of his invention by allowing portable devices and wireless control of applications in his network as taught by Ortony.

37> As to claim 44, Frese does not disclose a method wherein the portable computing platform includes a touch screen, and the interface constructs include graphical interface elements accepting inputs via the touch screen.

38> Ortony discloses a method wherein the portable computing platform includes a touch screen, and the interface constructs include graphical interface elements accepting inputs via the touch screen [column 2 «lines 39-48» | column 6 «line 62» to column 7 «line 14»]. It would have been obvious to one of ordinary skill in the art to implement Ortony's portable computing platform and touch screen functionality into Frese as such it allows the user direct point and click control of the remote controlled applications.

Art Unit: 2152

39> As to claim 45, Frese does not disclose a portable computing platform that is palm-sized.

40> Ortony discloses a portable computing platform that is palm-sized [column 4 «lines 13-19»]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented Frese's computing platform as a portable computing platform to increase the functionality of his invention by allowing portable devices and wireless control of applications in his network as taught by Ortony. Frese further suggests this implementation, disclosing that other computing platforms may be used in his network [column 6 «lines 65-66»].

41> Claims 40 and 41 are rejected under 35 U.S.C § 103(a) as being unpatentable over Frese and Ortony, in further view of Myers et al, "Collaboration Using Multiple PDAs connected to a PC" ["Myers"].

42> As to claim 40, Frese does disclose remote execution of computer programs over a network but does not explicitly disclose a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for opening a presentation for display on a display coupled to the network, under control of the particular processor, and navigating slides within the presentation.



Art Unit: 2152

43> Myers discloses a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for opening a presentation for display on a display coupled to the network, under control of the particular processor, and navigating slides within the presentation [page 6 «section titled “PowerPoint Version”»]. It would have been obvious to one of ordinary skill in the art to have reasonably inferred and implemented a slide presentation application into Frese’s remote control method as taught by Myers. One would have been motivated to perform the implementation in Frese to allow users access to existing applications such as PowerPoint.

44> As to claim 41, Frese does disclose remote execution of computer programs over a network but does not explicitly disclose a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for editing slides within the presentation.

45> Myers discloses a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for editing slides within the presentation. [page 6 «section titled “PowerPoint Version”»]. It would have been obvious to one of ordinary skill in the art to have reasonably inferred and implemented a slide presentation application into Frese’s remote control method as taught by Myers. One would have been motivated to perform the implementation in Frese to allow users to control existing applications such as PowerPoint.

Art Unit: 2152

46> Claim 43 is rejected under 35 U.S.C § 103(a) as being unpatentable over Frese and Ortony, in further view of Whitehead.

47> Frese does not disclose a method wherein the communication link comprises an infrared link.

48> Whitehead discloses a communication link comprising an infrared link, and that its use is well known in the art [column 6 «lines 20-25»]. Therefore, it would have been obvious to one of ordinary skill to have reasonably inferred an implementation of an infrared wireless network as Frese's network, thereby increasing the number of computing platforms with which Frese's system is compatible, most notably, infrared-enabled and wireless devices.

### *Conclusion*

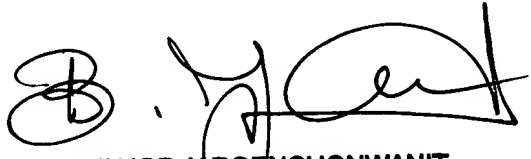
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Thursday [7:00 AM to 5:00 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC



**BUNJOB JAROENCHONWANIT**  
**PRIMARY EXAMINER**